APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/081,872	05/20/98	MESSING	J

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EXAMINER
MEISLAHN, D

ART UNIT	PAPER NUMBER
2767	3

DATE MAILED:
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/081,872	Applicant(s) Messing
	Examiner Douglas Meislahn	Group Art Unit 2767

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ___3___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-19* _____ is/are pending in the applicat

   Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-19* _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on ___May 20, 1998___ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

   ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

      ☐ received.

      ☐ received in Application No. (Series Code/Serial Number) _____ .

      ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   *Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). ___2___

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Oath/Declaration

1.   Applicant has not given a post office address anywhere in the application papers

as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or

declaration. A statement over applicant's signature providing a complete post office

address is required.   The address given is assumed to be the inventor's residence,

and, without a specific statement, cannot be assumed to be the postal address as well.

Drawings

2.   Figure 1 should be designated by a legend such as --Prior Art-- because only

that which is old is illustrated. See MPEP § 608.02(g).

Specification

3.   Amend the specification so that the summary precedes the description of the

drawings.

4.   The disclosure is objected to because of the following informalities: page 6, fifth

written line – add an "an" at the end of the line; page 6, eighth written line – add a "be"

after "to"; the last sentence of the second paragraph on page eight has no verb; and, in

the same paragraph, "similar" should read "similarly." .

        Appropriate correction is required.

Claim Objections

5.   Claims 1-8 are objected to because of the following informalities: in part (d) of

the first claim, the third line needs an "a" after "such." There is no need for the semi-

colon at the end of the fourth line of part (h) of claim 1. Appropriate correction is required.

Not an objection but part (f) talks about the a second resolving unit. Is there mention of a first resolving unit?

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Part (d) of the first claim talks about differentiating between template and boilerplate information; this information has not been mentioned in the specification. Add a brief discussion of how this step is done and what types of information constitute template and boilerplate information. Applicant says that information is "wrapped" but does not say what wrapping entails. In the examiner's experience, wrapping generally includes encryption, e.g. key wrapping. Please add commentary on how precisely the active X (com) object wraps the digital signature. There is no mention in the specification about how one would sign a message without using public key cryptography. Although the examiner is aware of

certain methods, the methods that the applicant intends need to be detailed in the specification.

The amendments required in the above paragraph will not necessitate filing a continuation-in-part application (CIP) because the first simply requires putting material that was *originally* in the claims into the specification. The second change explains more clearly a process already in the disclosure. Addition of material to the claims that is not now in the specification would require the filing of a CIP.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9.   Claims 1-15, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10.   Claim 1 recites the limitation "the computer" in part (b). There is insufficient antecedent basis for this limitation in the claim. Adding "a computer including" before "a central processing unit" in the first line of part (b) would overcome this rejection.

11.   Claim 1 recites the limitation "said receiver computer" in part (e). There is insufficient antecedent basis for this limitation in the claim. The examiner assumes that the receiver computer is the one that is described having a CPU and memory in part (b).

12.   Claim 1 recites the limitation "the unique information of the server computer" in part (g). There is insufficient antecedent basis for this limitation in the claim. Both "the unique information" and "the server computer" lack antecedent basis. The server

computer is also interpreted to be the computer described in part (b) while the unique information is, judging from the claim, different from formerly mentioned unique information. Change "the unique information" to "unique server information."

13. Claim 1 recites the limitation "said digital signature" in part (h). There is insufficient antecedent basis for this limitation in the claim. Add "thereby creating a digital signature" after the word "parameters" to overcome this rejection.

14. Claims 2 and 11 recite the limitation "the same" in fourth line. There is insufficient antecedent basis for this limitation in the claim. Rewrite the claims so they do not use this phrase.

15. Claims 4, 12, and 19 recite the limitation "the signer" in the second line. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes that "the signer" is the user, not the computer that is signing the signature.

16. Claims 5, 13, and 18 recite the limitation "said archival unit" in the second line. There is insufficient antecedent basis for this limitation in the claim. Add "thus being and archival unit" after "purposes" in the second line of the claims.

17. Claim 6 recites the limitation "the computer data" in the first line. There is insufficient antecedent basis for this limitation in the claim. Delete "the."

18. Claim 9 recites the limitation "each datum" in part (b). There is insufficient antecedent basis for this limitation in the claim.

19.   Claim 10 recites the limitation "said related parameters" in its first line. There is insufficient antecedent basis for this limitation in the claim. The examiner has no idea what these related parameters could be and hence has not treated this claim with respect to the prior art.

20.   Claim 16 recites the limitation "the user" in part (a), "the document" in part (b), "the system clock information" in part (c), "the server information" in part (c), "the combined" in part (d), "the signed" in part (e), "the electronic signature" in part (e), and "the computer user" in part (e). There is insufficient antecedent basis for this limitation in the claim. For most of the above rejections, either deleting "the" or changing it to read "a" or "an" will overcome the rejection. Also, delete "certain such" in part (c).

21.   The above rejections arise any time the words "the" or "said" are used prior to words that have not been used before. Please re-read the claims and search for any errors that the examiner missed.

22.   In part (g) of claim 1, applicant uses the phrase "in combination with or apart from" which is indefinite in that it does not indicate how something is to be done. In the examiner's opinion, these different methods should be split into two separate claims.

23.   Part (b) is questioned because it says that the CPU verifies a users rights to access a computer. Is this what the claim is intended to say?

24.   The examiner is unsure of the meaning of part (b) of claim nine. His interpretation is that the program stores the data.

25. Claim 5 is rejected because it is directed to a method while the claim from which

it depends is directed to a program.

Claim Rejections - 35 USC § 101

26. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

27. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. All independent claims are directed to

electronic signature programs. Computer programs not embodied on a computer

readable medium are not patentable. Add "embodied on a computer readable medium"

after "electronic signature program."

Also, claim 1 includes a bounty of devices and methods in its program. To begin

with, a program is not a physical entity in that it cannot include devices. Also, methods

and devices cannot be claimed interchangeably. Considering that the elements of the

claim are devices, claim 1 and its dependent claims should be written as an apparatus,

in the examiner's opinion. That is, the preamble would read "An apparatus for the

creation, ..."

In claim 16, part (c) is not statutory because it does not have any functionality.

That is, "providing a means" does not accomplish anything. It is not until that means

does something that the claim becomes statutory. Rewording part (c) to begin

"incorporating user supplied information" would overcome this rejection. Also in claim

16, the examiner does not see the need for the words "to be effectuated." Please delete

them. There are also internal inconsistencies within the claim, such as part (b) referring

to "the document or transaction" while part (c) only mentions "the transaction."

The above rejections based upon 35 USC 112 and 101 are only exemplary.

Although the examiner has attempted to mention all of the errors, other rejections will

most probably arise upon further examination.

Claim Rejections - 35 USC § 102

28.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

29.   Claims 1, 3, 8, 9, and 16 are rejected under 35 U.S.C. 102(b) as being

anticipated by Haber et al. (5136647).

Step 13 of Haber et al.'s first figure shows an agency obtaining a document,

which anticipates part (b) of claim 16. Step 15 shows the addition of time data, meeting

part (c) of the claim. Step 17 is the signing of the signature and time data and

anticipates part (d) of the claim. Step 19, the return of the signed data to the author,

meets part (e). In column 6, lines 8-15 say that the author includes an identifier, which

serves as an authenticator. This meets the limitations of part (a) of claim 16.

Claim 9 is met in similar fashion because the agency must store the data

received from the author in order to operate upon it.

As it is best understood, all of the elements of claim 1 are also met by Haber et

al. Elements (a), (c), (e), (f), (h), and (i) have already been discussed. Element (b), a

CPU connected to memory, is inherent. From lines 25 through line 50 of column 6,

Haber et al. discuss simplifying strings so that they can be signed. This, in conjunction

with the original hashing of the document to be timestamped, meets element (d). The

examiner, as had already been stated, is unsure as to what the extent of element (g)

entails and therefore is unable to apply an art rejection to this element.

30.   Claims 1, 3, 6, 9, and 16 are rejected under 35 U.S.C. 102(b) as being

anticipated by Haber et al. (5136646).

This rejection is largely the same as the rejection based upon the '647 patent.

The difference is that here the TSA hashes, as opposed to signs, the time

stamp/document data. This can be seen in figure 1 and does not use public-key

cryptography.

Claim Rejections - 35 USC § 103

31.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

32.   Claims 2, 5, 7, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Haber et al. (5136647 or 5136646) in view of The Microsoft Press

Computer Dictionary, 3rd edition (1997).

Haber et al. teach a timestamping authority. They do not say that the authority

archives the data. Official notice is taken that archiving information, such as documents

and their accompanying signatures, with a trusted third party is old and well-known. For

example, companies keep track of employee's Internet usage with an automatic

application. Sometimes, the findings of this application are used as a grounds for firing

an employee. This employee might feel slighted and decide to sue for wrongful

dismissal. A court would want proof, at which point the company could produce the

network event log showing the former employee's activities. The court would want proof

that the document had not been altered by the company, which could be achieved by

including a timestamped signature, such as the one described in Walker et al. or by

storing the log with a trusted third party immediately after its generation. On page 512,

the cited dictionary teaches WORM memory as useful for saving data for extended

periods of time. Therefore it would have been obvious to a person of ordinary skill in

the art at the time the invention was made for the timestamping authority to archive the

signed data or send the data to a court-approved repository.

33.   Claims 4, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Haber et al. (5136647 or 5136646) in view of Micali (5666420).

Haber et al. teach a timestamping authority. They do not say that the author

countersigns the timestamped document. In the first paragraph of column six, Micali

presents the advantage of countersigning a document, saying that it saves the

countersigner from accidentally signing a message that has been maliciously prepared.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the author in Haber et al.'s system to countersign data received from the certification authority, as taught by Micali, as protection from maliciously formulated data.

34.   Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haber et al. (5136647 or 5136646).

Haber et al. teach a timestamping authority. They do not say that the process of timestamping is started by pressing a button. Official notice is taken that starting transactions by the press of a button is old and well-known. A recent example is Amazon.com's much discussed one-click method of shopping. Other examples include warnings that one is attempting to access a secure web-page and sending credit information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to start the timestamping process of Haber et al. by clicking a button at an author's console.

35.   Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber et al. (5136647 or 5136646).

Haber et al. teach a timestamping authority. They do not say that the material that is timestamped is from a form. Official notice is taken that forms, such as web-based financial transactions, that would benefit being timestamped are old and well-known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the timestamping method of Haber et al. on

forms such as web-based financial transactions to provide proof of the transactions' time and date of occurrence.

Conclusion

36.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Konheim (4264782), Haber et al. (Re 34954), Newman (5671285), and Sampson et al. (5802499).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9AM - 6PM, except for every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.
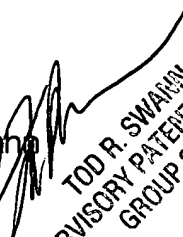
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J Meislahn
Examiner
Art Unit 2767

DJM
March 24, 2000